

**REMARKS**

This paper is being filed in response to the Office Action dated February 12, 2003 that was issued in connection with the above-identified patent application. Applicants also enclose herewith an Information Disclosure Statement, a corresponding Form PTO-1449, copies of 37 documents, and the fee required pursuant to 37 C.F.R. §1.17(p) and §1.97(c)(2). Applicants respectfully request reconsideration of the instant application in view of the remarks presented herein.

Claims 1-15 are pending.

As a preliminary matter, Applicants thank the for acknowledging that the instant application complies with the sequence rules.

The Examiner has rejected claims 10-11 and 13-14 under 35 U.S.C. §112, second paragraph as allegedly indefinite. The Examiner has alleged that it is unclear how claims 10-11 further limit the scope of claim 1. The Examiner has not indicated a specific basis for rejecting claims 13-14 under 35 U.S.C. §112, ¶2. Therefore, Applicants respectfully request clarification.

Applicants traverse this rejection and assert that claims 10-11 and 13-14 are clear and definite in compliance with 35 U.S.C. §112, ¶2. The instant invention contemplates homogenizing an original cDNA library into a plurality of sublibraries based on graded  $C_0t$  values. *See e.g.* Specification, pages 22-23, paragraphs [0056] to [0058]. A non-limiting illustration is provided in Example 1 where healthy infant brain cDNA library was homogenized into two sublibraries on the first iteration (paragraph [0096]), three sublibraries on the second iteration (paragraph [0097]), and two sublibraries on the third iteration (paragraph [0098]).

Applicants respectfully invite the Examiner's attention to claim 1 and note that claim 1 does not recite a particular **number of grades** of the original library based on graded  $C_0t$

values. In contrast, claim 10 recites a range of "**3 to 8 grades** of  $C_0t$ " values. Claim 11 further recites "**3 grades**" and recites a range of  $C_0t$  values for each grade. Applicants respectfully assert that the scope of claims 1, 10, and 11 clearly differ with respect to the number of  $C_0t$  grades. Therefore, Applicants respectfully request withdrawal of this rejection.

The Examiner has rejected claims 1-10, 12, and 14 under 35 U.S.C. §102(b) as allegedly anticipated by U.S. Patent No. 5,482,845 issued to Soares et al. (hereinafter "Soares"). The Examiner has alleged that Soares teaches a method of cDNA sequencing comprising all of the limitations recited in claims 1-10, 12, and 14.

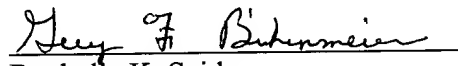
Applicants traverse this rejection and assert that claims 1-10, 12, and 14 are patentable over, not anticipated by, Soares. For a reference to anticipate, it must teach each and every element of the claim. *See* MPEP §2131. Soares teaches a method of normalizing a directional cDNA library. *See e.g.* Soares, Abstract. However, Soares does not teach subtracting the normalized library with probes that are synthesized on the basis of sequence information obtained from selected clones. Applicants respectfully invite the Examiner's attention to Soares at Col. 5, lines 35-38 and Col. 6, lines 1-6, which clearly indicate that Soares teaches only **single pass** sequencing. Soares, therefore, does not teach the systematic, **iterative** sequencing and subtraction of the instant claimed invention. Specifically, Soares fails to teach "(5) repeating (3) and (4) 1-5,000 times" as recited by claim 1 of the instant invention. Moreover, Soares fails to teach a method of cDNA sequencing wherein clones are selected, sequenced, and then removed from the (sub)library by subtraction on the next pass. Since Soares fails to teach a method of iterative sequencing and subtraction, it fails to anticipate claims 1-10, 12, and 14. Applicants, therefore, respectfully request withdrawal of this rejection.

Applicants assert that claims 1-15 are in condition for allowance and respectfully request prompt issuance of a Notice of Allowance.

Applicants enclose herewith the fee required under 37 C.F.R. §1.17(p) and §1.97(c)(2). Applicants do not believe that any additional fees are required with this paper. Nevertheless, the Commissioner is hereby authorized to charge any fees occasioned by this submission not otherwise enclosed herewith to Deposit Account No. 02-4377. Please credit any overpayment of fees associated with this filing to the above-identified deposit account. A duplicate of this page is enclosed.

Respectfully submitted,

May 12, 2003

  
Rochelle K. Seide  
PTO Reg. No. 32,300  
Attorney for Applicants

Guy F. Birkenmeier  
PTO Reg. No. 52,622  
Agent for Applicants

BAKER BOTTS, L.L.P.  
30 Rockefeller Plaza  
New York, NY 10112  
(212) 408-2500

Enclosures